REMARKS

Reconsideration of the present application in view of the above amendments and the following remarks is respectfully requested.

I. Status of the Claims

Claims 1-151 are pending in this application. Claims 9-14, 18-31, 45-63, 77-95, 109-127, 129-136, and 141-151 have been withdrawn from consideration. In the Office Action mailed on July 21, 2003, claims 1-8, 15-17, 32-44, 64-76, 96-108, 128 and 137-140 were rejected. Claims 1, 6, 33, 38, 42, 65, 70, 74, 97, 102, and 106 have been amended, and claims 32, 64, 96, and 128 have been canceled.

II. Affirmation of Election

As requested by the Examiner, Applicants hereby affirm the election, with traverse, of the invention of Group I, claims 2-8, 34-37, 44, 66-69, 76, 98-101, 108, and 137-140 and 39-44, which election was originally made by Philip E. Levy by telephone on November 1, 2002.

III. Rejection Under 35 U.S.C. § 112

The Examiner rejected claims 1-8, 15-17, 32-44, 64-76, 96-108, 128 and 137-140 under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More specifically, in independent claims 1, 33, 65 and 97, the Examiner identifies "analytical status data" as being defined in terms of itself. Applicant has amended claims 1, 33, 65 and 97 in response to this rejection, eliminating the element of analytical status data entirely from claims 1 and 33 and revising the identification of the analytical status data element in claims 65 and 97. The remaining claims

identified by the Examiner have either been cancelled, withdrawn or are dependent upon the identified independent claims.

IV. Rejection Under 35 U.S.C. § 102

The Examiner rejected claims 1-8, 15, 16, 32-40, 42-44, 64-72, 74-76, 96-104, 106-108, 128 and 137-140 under 35 U.S.C. §102(e) as being anticipated by Jacobsen. The Examiner identifies: a plurality of sensors for sensing global positioning, ECG, blood pressure, breathing rate or oxygen saturation; processors or computing devices physically coupled to the sensors; a second computing device, coupled to the sensors, which analyzes the sensor signals such that instructions may be sent to a display; a memory unit; additional processing for diagnosis, alarms and messages; and wireless transceivers. The Examiner does not particularly point out which elements of the claim correspond to the identified elements.

Applicant has, however, amended independent claims 1, 33, 65 and 97 in response to this rejection. All other identified claims are dependent upon these independent claims and therefore contain all of the relevant limitations thereof. Applicant has amended the claims to include the limitation of: "generating derived data based on said data indicative of at least a first parameter and a second parameter, said derived data comprising a third parameter of said individual, said third parameter being an individual status parameter that cannot be directly detected by any of said at least two sensors."

The Jacobsen reference relates primarily to the detection of directly observable physiological conditions of the wearer. At col. 11, lines 17-20, Jacobsen states: ". . . integrated sensor unit 14 simply senses physiological status and generates signals . . ." The remainder of the disclosure is consistent with this position, in that raw data is generated from the sensors and reported to the users in the form of ambient temperature, body surface temperature, heart rate,

breathing rate, position, motion status, shivering, blood pressure and oxygen saturation (col. 6, lines 23-31). Each of these parameters is detected by an appropriate, directly correlated sensor or sensor array. Applicants distinguish the claimed invention, as currently amended, as requiring the detection of certain physiological or contextual parameters and deriving other parameters which cannot be directly measured by mere selection of appropriate sensors. Jacobsen contains no disclosure or other teaching of the mathematical or other computational derivation of these unmeasurable parameters, merely the reporting of raw, or directly measured data points or parameters. As such, Applicants respectfully submit that claims 1, 33, 65 and 97, which each contain this particular limitation, are allowable over the cited references. Applicants respectfully submit that claims, 2-8, 15, 16, 34-40, 42-44, 66-72, 74-76, 98-104, 106-108 and 137-140, which are dependent upon one of claims 1, 33, 65 and 97 and contain the relevant limitations regarding derived data, are also allowable for the same reasons. Claims 32, 64, 96, and 128 have been canceled.

V. Rejection Under 35 U.S.C. § 103

The Examiner rejected claims 17, 41, 73 and 105 under 35 U.S.C. §103(a) as being anticipated by Jacobsen in light of Pearlman, et al. The Examiner states that Jacobsen teaches all of the claimed invention with the exception of a tactile output device, required by the instant claims, which is identified in Pearlman.

It is well settled that to establish a prima case of obviousness, one must show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." Tec Air, Inc. v. Denso Manufacturing Michigan Inc., 192 F.3d 1353, 1359-60 (Fed. Cir. 1999), *quoting* In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Furthermore, "[w]hen a rejection

depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Rouffet, 149 F.3d 1350, 1355. Applicants acknowledge that the Jacobsen reference describes a remote personnel monitoring device. Applicants also acknowledge that Pearlman describes a wrist pager with tactile alarm capabilities. There is, however, no teaching, suggestion or motivation to combine the Jacobsen reference with Pearlman to create a monitoring device with a tactile alarm. On this specific subject, the Federal Circuit has clearly stated:

> '[V]irtually all inventions are combinations of old elements.' Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'

In re Rouffet, 149 F.3d at 1357 (citations omitted). Moreover, "[t]o prevent the use of hindsight based on the invention to defeat patentability of the invention, [the Federal Circuit] requires the examiner to show a motivation to combine the references that create the case of obviousness." Id. The Jacobsen provides a variety of output options for the data which is primarily utilized by remote monitoring personnel. Tactile feedback, especially as taught by Pearlman, is for the primary benefit of the wearer. As such, no motivation to add such tactile feedback to the Jacobsen remote monitoring device. Accordingly, Applicants respectfully submit that a rejection under 35 U.S.C. §103(a) based on the Jacobsen reference in view of Pearlman would be improper, as doing so would involve the use of hindsight reconstruction of the present invention as a "blueprint for piecing together elements in the prior art."

Finally, the claims, as currently amended, are not taught nor suggested by Jacobsen for the reasons stated above relating to the requirement of derivation of parameters which cannot be directly measured by the sensors. As a result, Applicants submit that the claims are allowable over the combination of the Jacobsen and Pearlman references.

CONCLUSION

Based on the foregoing remarks, Applicants respectfully submit that claims 1-8, 15-17, 33-44, 65-76, 97-108, and 137-140 are in condition for allowance.

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,

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